



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Pat nt and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/384,315	08/27/99	BOUILLLOUX	A ATOCM-154

IM71/0119  
MILLEN WHITE ZELANO & BRANIGAN PC  
ARLINGTON COURTHOUSE PLAZA I  
2200 CLARENDON BOULEVARD STE 1400  
ARLINGTON VA 22201

EXAMINER

SELLERS, R

ART UNIT	PAPER NUMBER
----------	--------------

1712

6

DATE MAILED: 01/19/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/384,315

Applicant(s)

BOUILLOUX ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-19 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1712

This application contains claims directed to the following patentably distinct species of the claimed invention:

- 1) The thermoplastic polymers such as the polyamide or saturated polyester in claim 5.
- 2) Component (A) comprising an unsaturated monoepoxide or diepoxide.
- 3) Component (B) comprising an unsaturated carboxylic acid anhydride.
- 4) Component (C) comprising an unsaturated carboxylic acid or  $\alpha,\omega$ -aminocarboxylic acid.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species within each of items 1) to 4) hereinabove for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-19 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1712

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to I. William Millen on November 30, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

The reply to this requirement to be complete must include an election of each of the species to be examined even though the requirement be traversed (37 CFR 1.143).

Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1712

Each of components (A), (B) and (C) designated as "a compound" in claim 1, lines 4, 6 and 8 and as "a product" on page 2, lines 6, 7 and 9 of the specification are not accurately defined. The disclosure describes **(A)** as either a copolymer of ethylene and an unsaturated epoxide, a polyolefin grafted with an unsaturated epoxide (page 3, lines 16-18), or a compound having two epoxide groups (page 4, lines 22-24), **(B)** as either a copolymer of ethylene and an unsaturated carboxylic acid anhydride, or a polyolefin grafted with an unsaturated carboxylic acid anhydride (page 4, lines 27-29), and **(C)** as a partially or completely hydrolyzed copolymer of ethylene and an unsaturated carboxylic acid anhydride, a partially or completely hydrolyzed copolymer of a polyolefin grafted with an unsaturated carboxylic acid anhydride (page 5, lines 11-15), or an  $\alpha,\omega$ -aminocarboxylic acid (page 5, lines 22-24).

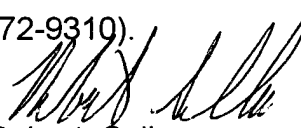
In order to satisfy the requirements of 35 U.S.C. 112, first paragraph, enablement and 35 U.S.C. 112, second paragraph, components (A), (B) and (C) would be more concisely denoted as components which embrace compounds such as a diepoxide compound of (A) and an  $\alpha,\omega$ -aminocarboxylic acid of (C) as well as the copolymers and graft polymers. The components should be limited to the species set forth in the previous paragraph for proper enablement.

Art Unit: 1712

Claims 10 and 15-19 do not conform to the requirements of 35 U.S.C. 112, first paragraph. The specification supports and enables only epoxide-functional copolymers and graft copolymers and diepoxide compounds as component (A) (claims 10, 15 and 16) which are not unsaturated epoxides, and only carboxylic acid-functional copolymers and graft copolymers as component (C) which are not unsaturated carboxylic acids (claims 17-19).

The terms "unsaturated epoxide" and "unsaturated carboxylic acid" denote a compound or monomer having one unsaturated group and one epoxide or carboxylic acid group, respectively, which are not supported or enabled by (co)polymers wherein the unsaturation of the monomers is consumed by copolymerization.

Any inquiry concerning this communication should be directed to Robert Sellers at telephone number (703) 308-2399 (Fax no. (703) 872-9310).



Robert Sellers  
Primary Examiner  
Art Unit 1712

RS

1/18/01